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| In re Application of | : | OFFICE OF PETITIONS |
| Harold O. Schwartz et al | : | |
| Application No. 09/930,123 | : | DECISION GRANTING PETITION |
| Filed: August 14, 2001 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 3790-60721 | : | |

This is a decision on the petition, filed July 17, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for the failure to notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The petition is **GRANTED**.

The instant application was filed on August 14, 2001, which included a nonpublication request to not publish the application. The nonpublication request stated:

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

Petitioner herein, Mr. Michael P. Girard, states that, on August 8, 2002 a PCT application was filed in the United States receiving office and a corresponding Malaysian application was filed on August 14, 2002. Petitioner further states that a request to rescind the previous nonpublication request was filed on August 5, 2002. The request to rescind filed by certificate of mailing on August 5, 2002, and received in the USPTO on August 13, 2002, did not inform the USPTO that this application was being filed as a counterpart international or foreign application. Notification of the filing of the counterpart international or foreign application as required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was provided at the time of filing of the instant petition.

As the notification to the USPTO of the filing on August 8 and August 14, 2002 of the counterpart international or foreign application did not occur within 45 days of such filing, this application is regarded as abandoned as of midnight on September 22, 2002.

Petitioner states that it is not believed a separate notification of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii) was required because the rescission of the nonpublication request did not occur subsequent to the international or foreign filing. Therefore, there was no requirement to file an additional notice of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii).

It is noted that a request to rescind was mailed via certificate of mailing on August 5, 2002 but was not received in the USPTO until August 13, 2002. As noted in the Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(i), 1272 OG 1 (July 1, 2003), available at <http://www.uspto.gov/web/patents/patog/week26/>; no benefit is given to a certificate of mailing (37 CFR 1.8) on a rescission of a nonpublication request since such is not considered to be a paper required to be filed in the USPTO as provided for in 37 CFR 1.8(a). Therefore, the terms of 37 CFR 1.8 by their terms do not apply in this situation, and the USPTO must use the actual date of receipt in the USPTO, as defined in 37 CFR 1.6, in determining whether the nonpublication request was rescinded before or on the date of the filing of the counterpart or foreign application in an eighteen-month publication country such that the application may be considered an application in which the nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) was never made. In the instant case, since the earliest filing of a counterpart or foreign application in an eighteen-month publication country occurred on August 8, 2002 and the request to rescind was not received in the USPTO until August 13, 2002, a proper notice of foreign filing was required to be filed in the USPTO no later than 45 days after the date of filing of the counterpart application to avoid abandonment of the application. The file record fails to evidence that such notice was received prior to or within 45 days of the filing of the counterpart applications in an eighteen month publication country that requires publication 18 months after filing.

Petitioner further argues that it is his understanding that the USPTO considers a request to rescind a nonpublication request as the proper notice of foreign filing. In this regard, petitioner references the different forms endorsed and distributed by the USPTO where one form only contained the sentence "I hereby rescind the request that the above-identified application not be published under 35 U.S.C. 122(b)," while a later version of the form included the note that "[f]iling this rescission of a previous nonpublication request is considered the

notice of a subsequent foreign or International filing required by 35 U.S.C. 122(b)(2)(B)9iii) and 37 CFR 1.213(c) if this rescission is filed no later than forty-five days [sic] (45) days after the date of filing of such foreign or international application."

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

The American Inventors Protection Act of 1999 required publication of certain patent applications filed on or after November 29, 2000, and allowed applicants to request nonpublication if the invention disclosed in the application had not been and would not be the subject of an application filed in another country, or pursuant to an international agreement that required publication of patent applications eighteen months after filing. The Act permitted applicants to rescind the nonpublication request at any time, but also required applicants to notify the USPTO if they had made a nonpublication request (with the certification that the invention disclosed in the application had not been and would not be "foreign filed," and then did foreign file). If an applicant requested nonpublication, and then did not provide notice of foreign filing no later than 45 days of the foreign filing, the statute provides that the application would be regarded as abandoned. An applicant who rescinded a nonpublication request after filing the U.S. application but before foreign filing the application is not understood to be required to also file a notice of foreign filing, since the rescinding of the nonpublication request prior to foreign filing would nullify the nonpublication request (if received in the USPTO prior to the date of foreign filing).

Further, petitioner is advised that, because the USPTO expected rescission (applicants who initially requested nonpublication, but later changed their mind as to the desire for nonpublication) to be an uncommon, but likely, event, the USPTO initially provided a form for rescission. The USPTO did not initially provide a form for a notice of foreign filing, because the USPTO did not anticipate receiving many such notices since it would only be necessary if applicant had a change of heart and decided to file abroad after having made the decision not to file abroad when he initially filed in the United States. In general, the USPTO provides forms for common circumstances, but not for rare situations (as was not expected that many notices of foreign filing would be filed). The USPTO provides, as a courtesy, suggested forms for use. It is noted

that USPTO's form for rescinding a nonpublication request, PTO/SB/36 (dated 4/01 or 10/01) provides a note that states "[f]iling this rescission of a previous nonpublication request is considered the notice of subsequent foreign or international filing required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) if this rescission is filed no later than forty-five (45) days after the date of filing of such foreign or international application" instead of an affirmative statement. The USPTO form for a rescission can be accepted as a notice of foreign filing because it makes some mention of foreign filing. Applicant-created rescission forms that fail to include any indication from the applicant that the paper filed by applicant is intended also to be a notice of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii) cannot be treated as a notice of foreign filing. An applicant who has removed the language on the form intended to provide notice of foreign filing cannot be considered to be providing such a notice when the applicant has done all that is possible to avoid providing a notice of foreign filing under 35 U.S.C. 122(b)(2)(B)(iii) to the USPTO. Applicant is reminded that the USPTO has no authority to waive a requirement of the patent statute. Thus, applicants are cautioned to familiarize themselves with the requirements of the patent statute to ensure that a submission, whether on a USPTO-provided form or an applicant-created form that is modeled after a USPTO-created form, meets the requirements of the patent statute that are applicable to the particular submission. The mere filing of a rescission does not imply that the invention has been or will be filed in another country, and instead suggests that the applicant now desires to have the application published so the applicant could take advantage of the provision rights provisions of the statute. For the above-stated reasons, if a rescission does not include any mention of a foreign filing, the rescission cannot be considered as a notice of foreign filing to satisfy the requirement of 35 U.S.C. 122(b)(2)(B)(iii).

In view of the above, and since a notification as required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) was not filed within 45 days of the counterpart international or foreign application, this application is regarded as abandoned as of midnight September 22, 2002. Accordingly, a petition to revive this application pursuant to the provisions of 37 CFR 1.137(b) is the appropriate remedy to relieve this application from its abandoned status.

A petition to revive an application abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

- (1) the reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and

(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). However, while the statement of unintentional delay does not comply with the rule, the statement presented will be construed as meaning that "the entire delay in filing the required reply [notification of foreign filing under 35 U.S.C. § 122(b)(2)(B)(iii)] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. 35 U.S.C. § 41(c)(7). Therefore, the \$1,300 petition fee submitted is not refundable.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 1754 for appropriate action on the reply to the restriction requirement of May 1, 2003 received June 5, 2003.



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